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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/765,246	01/18/2001	Jonathan Lowthert	INTL-0510-US (P10479)	8160

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EXAMINER

DEMICCO, MATTHEW R

ART UNIT

PAPER NUMBER

2611

DATE MAILED: 08/02/2004

4

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/765,246

Applicant(s)

LOWTHERT ET AL.

Examiner

Matthew R Demicco

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 18 January 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-30 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 18 January 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 5 and 6.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Drawings***

1. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: 56 and 80. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

2. The drawings are objected to because in Figure 3, reference number 74 is used to depict both a bus and a BIOS. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

### ***Specification***

3. The disclosure is objected to because of the following informalities: on Page 15, Line 25 "a draft" appears to be a typographical error. Appropriate correction is required.

### ***Double Patenting***

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

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A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. Claims 1, 9-11, 18-19 and 21-22 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 9-11 and 19-22 of copending Application No. 09/764,748. Although the conflicting claims are not identical, they are not patentably distinct from each other because they are obvious variations.

Claim 1 of the instant application corresponds to Claim 1 of the '246 application.

Claim 1 differs in that it collects information about a characteristic of a receiver and provides the information to a remote system to select a subset of advertising from a database for use with the receiver. This is an obvious variation because collecting information, reporting the information to a remote system and selecting an ad from a database based on the information is well known in the art as disclosed by U.S. Patent No. 6,698,020 to Zigmond et al. Such a modification is desirable in order to increase revenue from advertisers by presenting ads to a user that relate to programming and products they are most likely to be interested in and subsequently purchase.

Claims 9-10 of the instant application correspond to Claims 9-10 of the '748 application.

Claim 11 of the instant application corresponds to Claim 11 of the '748 application. Claim 11 differs in the same manner as Claim 1 above.

Claims 18-19 of the instant application correspond to Claims 19-20 of the '748 application.

Claim 21 of the instant application corresponds to Claim 21 of the '748 application. Claim 21 differs in the same manner as Claim 1 above.

Claim 22 of the instant application corresponds to Claim 22 of the '748 application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

### ***Claim Rejections - 35 USC § 102***

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1-5, 7-15 and 17-29 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 6,698,020 to Zigmond et al.

Regarding Claim 1, Zigmond discloses a method comprising allowing the use of content on a content receiver (See Figure 5 and Col. 4, Lines 16-24), automatically interrupting the use of the content (Col. 7, Lines 26-29) and enabling the receiver to temporarily replace the content with advertising (Col. 7, Lines 30-36 and Col. 4, Lines 45-52). Zigmond further discloses collecting information about a characteristic of a receiver (Col. 9, Lines 21-45) and providing that information to a remote processor-based system (Col. 9, Lines 45-55 and Col. 4, Lines 55-67) to select, from an advertising

database (Col. 8, Lines 7-9), an advertising subset for use in connection with the receiver (Col. 7, Lines 61-67 and Col. 11, Lines 42-49).

Regarding Claim 2, Zigmond discloses a method as stated above in Claim 1, including receiving a plurality of advertisements (Col. 10, Lines 16-22) for storage on the local receiver. This reads on the claimed receiving an advertising database. Zigmond further discloses updating existing advertisements (Col. 14, Lines 6-9). This indicates that the system of Zigmond is capable of receiving advertisement data when data already exists on the receiver. This reads on the claimed combining the received database with advertising available on the receiver

Regarding Claim 3, Zigmond discloses a method as stated above in Claim 1, wherein determining information includes monitoring the activities of the user of the receiver (Col. 9, Lines 21-38).

Regarding Claim 4, Zigmond discloses a method as stated above in Claim 3, wherein determining information includes developing a database of information about activities undertaken by the user of the receiver (Col. 9, Lines 42-48 and Figure 5, reference numbers 61 and 82).

Regarding Claim 5, Zigmond discloses a method as stated above in Claim 4, including selecting advertisements stored on the remote processor-based system (Col. 8, Lines 7-9) based on information about the user of the receiver (Col. 11, Lines 14-49).

Regarding Claim 7, Zigmond discloses a method as stated above in Claim 1, including determining a characteristic of advertising (Col. 11, Lines 50-65) and

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comparing the characteristic to information about the use of the receiver (Col. 11, Lines 31-49).

Regarding Claim 8, Zigmond discloses a method as stated above in Claim 1, wherein the receiver is operable to receive television programming in addition to pay-per-view programming and other forms of video content (Col. 6, Lines 13-29). In such a television system, the user is able to choose programming they wish to watch (Col. 11, Lines 16-18). This reads on the claimed enabling a variety of content to be selected for play at any time.

Regarding Claim 9, Zigmond discloses a method as stated above in Claim 1, wherein predetermined times (Cols. 2-3, Lines 67-1) are specified in the video feed for insertion of advertising (Col. 7, Lines 26-29). This reads on the claimed including automatically replacing the content with advertising after allowing content to be used for a predetermined amount of time.

Regarding Claim 10, Zigmond discloses a method as stated above in Claim 1, including automatically determining at predetermined times whether to replace the content (Col. 7, Lines 26-29).

Regarding Claim 11, see Claim 1 above. Zigmond further discloses an article comprising a medium for storing instructions enabling a receiver to perform the method as stated above (Col. 6, Lines 40-61).

Regarding Claim 12, see Claim 8 above.

Regarding Claims 13-15, see Claims 3-5 above.

Regarding Claims 17, 18 and 19, see Claims 7, 9 and 10 above, respectively.

Regarding Claim 20, see Claim 2 above.

Regarding Claim 21, Zigmond discloses a system comprising a receiver (Col. 6, Lines 48-67) that receives the transmission of content (Col. 7, Lines 1-25). Further disclosed is the ability of the receiver to enable the use of content to be interrupted and temporarily replaced with advertising as stated above. This reads on the claimed "shell". Also disclosed is storage coupled to the receiver storing instructions (Col. 6, Lines 50-61) that enable the receiver to determine information about the use of the receiver and use the information to select the advertising as stated above.

Regarding Claim 22, Zigmond discloses a system as stated above in Claim 21, wherein the system is a television receiver (Col. 6, Lines 40-44).

Regarding Claims 23-24, see Claims 9-10 above.

Regarding Claim 25, see Claim 8 above.

Regarding Claims 26-27, see Claims 3-4 above.

Regarding Claim 28, Zigmond discloses a system as stated above in Claim 21 wherein the storage stores instructions that enable to receiver to access a database of available advertisements on a remote processor-based system (Col. 15, Lines 5-8).

Regarding Claim 29, see Claim 5 above.

### ***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person



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having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 6, 16 and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Zigmond et al.

Regarding Claim 6, Zigmond discloses a method as stated above in Claim 5.

Zigmond further discloses that the receiver may initiate a connection to the advertisement source to request a download of advertisements (Col. 15, Lines 2-8). This reads on the claimed accessing advertisements available on the remote processor-based system.

Further, Zigmond discloses an ad filter that pre-screens and accepts only advertisements from the source that meet ad selection criteria (Col. 15, Lines 17-23). What is not disclosed, however, is compiling a local electronic guide to advertising resources.

Official Notice is hereby taken that it is well known in the art to receive a listing of data when requesting a download, and further to use a list of data assets when pre-processing and selecting which assets are to be downloaded. This reads on the claimed compiling a local electronic guide to advertising resources by accessing advertisements available on the remote processor-based system. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the method of Zigmond with the list generation and processing of the well-known prior art in order to pre-screen and only download the required assets in order to conserve bandwidth and time.

Regarding Claims 16 and 30, see Claim 6 above.

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*Conclusion*

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- a. U.S. Patent No. 6,738,978 to Hendricks et al. discloses a television-based receiver with profile generation and targeted advertising.
- b. U.S. Patent No. 6,704,930 to Eldering et al. discloses a system for insertion of advertisements in a program stream.
- c. U.S. Patent No. 5,724,521 to Dedrick discloses an electronic advertising system with remote databases, user profiles, and a consumer matching process for targeting ads.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew R Demicco whose telephone number is (703) 305-8155.

The examiner can normally be reached on Mon-Fri, 9am - 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Faile can be reached on (703) 305-4380. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



mrd  
July 13, 2004



VIVEK SRIVASTAVA  
PRIMARY EXAMINER